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| EXAMINER | | | | |
| SLAWSKI, BRIAN R | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 4191 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/29/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,956

Applicant(s)

MASUCH, RALF

Examiner

BRIAN R. SLAWSKI

Art Unit

4191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 8 May 2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

THIN-LAYER CELL

Examiner: Slawski

S.N.: 10/530,956 Art Unit: 4191

April 22, 2008

Objections

1. Claim 1 is objected to because of the following informalities: the recitation, "the process comprising the following steps: ...(d) filling at least some regions of a filling chamber...with adhesive, and the liquid-tight securing of the thin layer...includes a softening of the thin layer..., which comprises removing the thin layer (18) after step (d)" is grammatically unclear. The examiner suggests a recitation such as, "the process comprising the following steps: ...(d) filling at least some regions of a filling chamber...with adhesive, wherein the liquid-tight securing of the thin layer...includes a softening of the thin layer..., and wherein the thin layer (18) is removed after step (d)."

Appropriate correction is required.

Claim Rejections—35 USC §112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since

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the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "in the range from 0.5 to 100 μm ," and the claim also recites "preferably from 1 to 50 μm and most preferably from 3 to 15 μm ," which is the narrower statement of the range/limitation.

Art of Record

4. The following prior art is made of record. Howitz et al. (WO 02/21115), discloses a process for producing a flow cell for optical analysis (col. 1, L. 8-9, L. 17-20). (These and subsequent citations to Howitz et al. refer to corresponding US 7,114,541.) The process of Howitz et al. comprises: providing a first **2** and second **1** window, the second window **1** having two flow channels **4** (Fig. 4; col. 5, L. 22-26, L. 29-31); applying a structured thin layer **5** to the second window **1**; sealing the thin layer **5** to the other window **2** to delimit a flow chamber **3**, the windows being optically transparent in the

region of the flow chamber; and filling a separate filling chamber between the windows with adhesive 6 (Fig. 2, 3; col. 4, L. 1-3; col. 6, L. 3-5, L. 18-23, L. 44-48). The process of Howitz et al. differs from the instant Claim 1 in that Howitz et al. do not disclose lowering the viscosity of the structured thin layer 5, nor finally removing the thin layer 5.

Allowable Subject Matter

5. The prior art of record, Howitz et al., does not teach lowering the viscosity of the structured thin layer, nor finally removing the thin layer, as recited in Claim 1. Further, these missing limitations are not taught in the analogous prior art. Claim 1, as well as Claims 2-6, which properly depend on and further limit Claim 1, are therefore allowed.

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN R. SLAWSKI whose telephone number is (571)270-3855. The examiner can normally be reached on Monday to Thursday, 7:30 a.m. to 5:00 p.m. ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan, can be reached on (571) 272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R. Slawski/
Examiner, Art Unit 4191

BRS

/Dah-Wei D. Yuan/
Supervisory Patent Examiner, Art Unit 4191